

01-04-05

AF/3673
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AP/

TRANSMITTAL OF APPEAL BRIEF

Docket No.
HO-P01426US2

In re Application of: William T. Carpenter

Application No. 09/773,815-Conf. #8585	Filing Date January 31, 2001	Examiner J. J. Kreck	Group Art Unit 3673
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Invention: METHOD OF MODIFYING THE AXIS OF ROTATION OF THE EARTH

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: November 4, 2004.

The fee for filing this Appeal Brief is \$ 500.00.

Large Entity Small Entity

A petition for extension of time is also enclosed.

The fee for the extension of time is _____.

A check in the amount of _____ is enclosed.

Charge the amount of the fee to Deposit Account No. 06-2375/09704227.
This sheet is submitted in duplicate.

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The Director is hereby authorized to charge any additional fees that may be required or
credit any overpayment to Deposit Account No. 06-2375.
This sheet is submitted in duplicate.

Dated: January 3, 2005

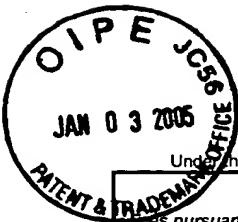
John M. Mings
Attorney Reg. No. : 35,955
FULBRIGHT & JAWORSKI L.L.P.
1301 McKinney, Suite 5100
Houston, Texas 77010-3095
(713) 651-5258

Appeal Brief Transmittal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. ER 147063315US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: January 3, 2005

Signature: Sandy Rork (Sandy Rork)



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Effective on 12/08/2004.
Pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2005

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 500.00)

Complete if Known

Application Number	09/773,815-Conf. #8585
Filing Date	January 31, 2001
First Named Inventor	William T. Carpenter
Examiner Name	J. J. Kreck
Art Unit	3673
Attorney Docket No.	HO-P01426US2

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____

Deposit Account Deposit Account Number: 06-_____ Deposit Account Name: Fulbright & Jaworski L.L.P.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

FEES CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		
	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fees Paid (\$)</u>
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEESFee Description

Each claim over 20 (including Reissues)

<u>Small Entity</u>	
<u>Fee (\$)</u>	<u>Fee (\$)</u>

50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
				<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- =	x	=	=		
<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>		
- =	x	=	=		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 =	/50	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 2402 Filing a brief in support of an appeal

Fees Paid (\$)

500.00

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	35,955
Name (Print/Type)	John M. Mines	Date	Telephone (713) 651-5258

Fee Transmittal

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FEE SUMMARY SHEET

Appeal Brief

Date: January 3, 2005
Time: 3:07 PM
Docket: HO-P01426US2

Filing Date: January 31, 2001
Application No: 09/773,815
Total Fee: \$ 500.00

Code	Amount	37 CFR	Fee Description	Listed on
2402	500.00	41.20(b)(2)	Filing a brief in support of an appeal	Fee Transmittal (PTO SB-17)



ATTORNEY DOCKET NO. P01426US2

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): William T. Carpenter

Serial No.: 09/773,815

Examiner: Kreck, John J.

Filing Date: January 31, 2001

Group Art Unit: 3673

Title: Method of Modifying the Axis of Rotation of the Earth

MS Appeal Brief - Patents
Commissioner for Patents
Alexandria VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on November 4, 2004.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. 1.192(c)):

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
 - A. Rejections under 35 U.S.C. § 112, first paragraph
 - B. Rejections under 35 U.S.C. § 103(a)

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C. Conclusion

IX. Appendix of claims involved in the appeal

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is William T. Carpenter, a U.S. citizen and resident of Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There is a total of 10 claims in the application, which are identified as claims 11-20.

B. Status of All the Claims

1. Claims canceled: Claims 1-10.
2. Claims withdrawn from consideration but not canceled: NONE.
3. Claims pending: Claims 11-20.
4. Claims allowed: NONE.
5. Claims rejected: Claims 11-20.

C. Claims on Appeal

The claims on appeal are: Claims 11-20.

IV. STATUS OF AMENDMENTS

Appellant did not file a Response to the Final Rejection dated May 4, 2004.

V. SUMMARY OF INVENTION

This invention is a method of modifying the earth-rotation vector in relation to the body of the planet or in inertial space by redistributing the mass in/or/on the crust of the earth. Such redistribution will change the center of mass of the Earth thereby causing a change in the earth-rotation vector.

VI. ISSUES

The issues remaining are:

1. Whether claims 11-20 are unpatentable under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. Whether claims 11-20 are unpatentable over Chao, B.F., Anthropogenic impact on global geodynamics due to water impoundment in major reserves, Geophys. Res. Lett., 22, 3529-3532, 1995 (hereinafter “Chao”) in view of JOHN WHITE, POLE SHIFT: PREDICTIONS AND PROPHECIES OF THE ULTIMATE DISASTER 80-81, 180-81 (Doubleday & Co., Inc. 1980) (“White”) and Hugh Auchincloss Brown, Cataclysms of the Earth 151-56 (Twayne Publishers, Inc. 1996) (“Brown”).

VII. GROUPING OF CLAIMS

For purposes of this Appeal Brief only, the claims have been grouped as follows:

Group I Claims 11-20.

The claims do not stand or fall as a group.

VIII. ARGUMENTS

Claims 11-20 are currently pending. The Examiner has rejected all pending claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and under 35 U.S.C. § 103 as unpatentable over Chao in view of White and Brown.

A. Enablement

The Examiner failed to make a *prima facie* case of lack of enablement by failing to construe the rejected claims and failing to provide a sufficiently reasoned basis for rejecting the claims. The Examiner rejected claims 11-20 on the grounds that the specification “fails to disclose any equations or methods to perform” the calculating step in claim 11. Without referring to any particular claim, the Examiner also rejected claims 11-20 on the grounds that Applicant’s disclosure “fails to disclose how the liquid would be captured and placed in predetermined locations,” “fails to disclose how much mass would be required to make an

appreciable change in the axis of rotation,” and that those failures “would require undue experimentation for one skilled in the art to carry out the claimed invention.”

“Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims.” MPEP § 2164.04. The Examiner construed only one term, “calculating,” in the pending claims. However, the Examiner contended that Applicant’s disclosure also “fails to disclose how the liquid would be captured and placed in predetermined locations,” “fails to disclose how much mass would be required to make an appreciable change in the axis of rotation,” and that those failures “would require undue experimentation for one skilled in the art to carry out the claimed invention.” The Examiner failed to construe all claim terms related to those grounds for rejection, including but not limited to terms related to the determining and positioning steps.

The Examiner also failed to rebut adequately the presumption that Applicant’s disclosure is accurate. *C.f., In re Bowen*, 492 F.2d 859, 862-63 (C.C.P.A. 1974). When the Examiner rejects a claim for lack of enablement, “it is incumbent upon the Patent Office . . . to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” *Id.* (emphasis added).

As Applicant discussed in its response to the non-final action mailed August 27, 2003, Applicant’s disclosure states that “[t]he invention may be readily understood by one of ordinary skill in the art without the benefit of a drawing.” (p. 4; lns. 17-18). Applicant’s disclosure also explains how a desired result from employing the present invention “can be reasonably determined by one of ordinary skill in the art” reviewing the disclosure. (p.4; lns. 20-28). The Examiner supported his conclusion that Applicant’s disclosure “would require undue experimentation for one skilled in the art to carry out the claimed invention” only with the statements that Applicant’s disclosure “fails to disclose how the liquid would be captured and placed in predetermined locations,” “fails to disclose how much mass would be required to make an appreciable change in the axis of rotation.” The Examiner failed to provide any evidence or explanation to demonstrate why Applicant’s disclosure must provide that information before one of ordinary skill may practice the present invention without undue experimentation. The Examiner failed to provide the required explanation or otherwise present sufficient reasoning to

rebut the presumption. Rather, the Examiner made only the bare statement that “Examiner has provided sufficient reasoning to the contrary; thus a *prima facie* case has been made.”

The Examiner also failed to support his conclusion that Applicant’s disclosure does not enable one of ordinary skill to practice the present invention without undue experimentation. “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) (enumerating eight “[f]actors to be considered in determining whether a disclosure would require undue experimentation”). The Examiner did not consider any of the *Wands* factors. Rather, the Examiner concluded, without reasoning, that “any experimentation would be ‘undue experimentation’” because “the nature of the claimed invention is such that any experimentation could have potentially catastrophic worldwide consequences.” (emphasis in original). In doing so, the Examiner completely disregarded any method of experimentation other than performing the method, itself (e.g., using known methods of calculating, simulating, or otherwise predicting results).

For the above reasons, the Examiner failed to make out a *prima facie* case of lack of enablement, and there is “no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” *Bowen*, 492 F.2d at 863.

B. Obviousness

The Examiner rejected all pending claims as unpatentable over Chao in view of White and Brown. However, the Examiner failed to make a *prima facie* case of obviousness. Without a *prima facie* case of obviousness, any rejection under 35 U.S.C. § 103 is improper and should be overturned. *In re Fine*, 837 F2d 1071, 1074 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the Examiner must satisfy three basic criteria. First, the Examiner must demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify a reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success. Finally, the Examiner must show that the cited prior art teaches or suggests all the claim limitations. *See M.P.E.P. § 2143.* Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

The Examiner concedes that Chao fails to explicitly disclose many of the claimed steps in independent claim 11. White and Brown also fail to disclose the claimed steps. The Examiner

failed to demonstrate any suggestion or motivation to modify Chao, White, or Brown to include the claimed steps. All three references identify the problem the present invention solves. As the Examiner characterizes them, White and Brown also emphasize the severity of the problem. However, neither White nor Brown provide a solution involving the claimed steps, and the Examiner does not point out any reference to the contrary. Rather, the Examiner only makes the bare statement that “it is the examiner’s position that the prior art suggests the claimed steps of selecting, calculating, determining, and positioning.”

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

C. CONCLUSION

Because no *prima facie* case of obviousness has been made, Appellant respectfully submits that claims 11-20 are patentable under 35 U.S.C. § 112 and 35 U.S.C. § 103. Therefore, reversal of the rejection is courteously solicited.

IX. APPENDIX OF CLAIMS

The text of the claims involved in the appeal are:

11. A method of modifying the axis of rotation of a planet comprising the steps of:

measuring the mass of a planet;
determining the center of mass of the planet;
characterizing the axis of rotation of the planet;
selecting a desired character of rotation;
calculating a moment of stability required to cause the desired character of rotation;
determining a position and a mass of a compensating substance sufficient to effect the moment of stability; and
positioning the mass in the position.

12. The method of claim 11 in which the position of the compensating substance is positioned an underground cavity.

13. The method of claim 11 in which the position of the compensating substance is positioned in an above ground cavity.

14. The method of claim 11 in which the substance is solid.

15. The method of claim 11 in which the substance is a liquid.

16. The method of claim 12 in which the substance is a liquid.

17. The method of claim 13 in which the substance is a liquid.

18. The method of claim 15 in which the liquid is water.

19. The method of claim 16 in which the liquid is water.

20. The method of claim 17 in which the liquid is water.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail ER 147063315 US in an envelope addressed to: MS Appeal Brief – Patents, Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: 1-3-05
Typed Name: Sandra K. Rork
Signature: Sandra K. Rork

Respectfully submitted,

By:

John M. Mings
Attorney/Agent for Applicant(s)
Reg. No. 35,955
Date: 1-3-05
Telephone No. 713-651-5258